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EXAMINER

DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/779,480	Applicant(s) TRUOG ET AL.	
	Examiner Tamra L. Dicus	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10, 12 and 14 is/are rejected.
- 7) ☒ Claim(s) 11, 13, 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04-03-06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The 112, second paragraph, is withdrawn due to Applicant's amendments.

The Double Patenting rejections are withdrawn due to Applicant's amendments.

However, the prior art rejections are still maintained, see MPEP 801, III: In a 35 U.S.C.

102(e)/103(a) rejection over a prior art patent, the reference patent is available for all that it

fairly discloses to one of ordinary skill in the art, regardless of what is claimed. In re Bowers,

359 F.2d 886, 149 USPQ 570 (CCPA 1966).

Election/Restrictions

Applicant's election of Group I, claims 1-7, in the Office Action mailed 10/31/2005 is acknowledged however; no election in writing was discussed in the reply filed on Mar. 03, 2006.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated over USPN 5,725,712 to Spain et al.

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Spain teaches a multilayer decorative dry paint laminate in this order: pressure sensitive adhesive (PSA) (144, Fig. 14 and associated text), thin flexible backing barrier (142, Fig. 14 and associated text), dry paint color layer (46, Fig. 14 and associated text), outer clear color layer (45, Fig. 14 and associated text releaseable contact with release liner), release liner (141, Fig. 14 and associated text, removable). Because the same PSA is taught, it is adapted for adhering the laminate to a substrate surface at room temperature. Spain teaches the dry color layer contains binder and pigment (col. 14, lines 57-68). That the PSA layer or overall laminate and its elements are adhered to a surface, or produced at a certain time and temperature and the release liner is peeled away from the dry paint layer are process limitations in a product claim and is given little patentable weight. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

Spain teaches the clear color coat layer functions as a barrier in a sufficient film thickness to prevent color coat pigment particles from migrating from the color coat through the clear coat and penetrating the surface of the clear coat for application to a painted car also containing non-pigmented solids (col. 10, lines 30-40, col. 15, lines 30-col. 16, line 4). The barrier is made of PVDF-acrylic resin composition including a non-pigment and Elvacite (same as Applicant's acrylic resinous composition including a non-pigment as page 25, lines 1-6 describe) at col. 11,

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lines 45-68 and col. 15, lines 65-col. 16, line 20. Such description is equivalent to Applicant's language to a thin flexible barrier having the thickness recitations, made of material that inhibits migration of discoloration-causing pigments including mono azo discoloration causing pigments from a painted substrate surface that sufficiently and essentially prevents color change in the color layer. Spain teaches color coats can also include metallic flake pigments and teaches the pigments dry on a substrate surface, thereby producing application of a color layer on a substrate surface (col. 37, lines 20-53). Thus, Spain was concerned with preventing defective color pigment transfer to painted surfaces (col. 20, lines 20-42, col. 37, lines 55-col. 38, line 4). That the barrier layer is able to capture or inhibit certain effects as claimed is not germane since it has been held that an element that is "being able to" perform a function is not a positive limitation but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (e.g. when x, then y...). Because the same structural elements are provided and produce the same end effects, the instant invention would inherently be expected to perform in the same manner.

Spain does not expressly disclose the thicknesses of the laminate or barrier as per claim 1.

However, it would have been obvious to one of ordinary skill in the art to produce a thickness as claimed, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. Thickness effects the strength.

Claims 1-2, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,649,003 to Spain et al.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Spain teaches a multilayer decorative dry paint laminate in this order: pressure sensitive adhesive (PSA) (144, Fig. 14 and associated text), thin flexible backing barrier (142, Fig. 14 and associated text), dry paint color layer (46, Fig. 14 and associated text), outer clear color layer (45, Fig. 14 and associated text, releaseable contact with release liner), release liner (141, Fig. 14 and associated text, removable). Because the same PSA is taught, it is adapted for adhering the laminate to a substrate surface at room temperature. See further col. 20, lines 20-42, col. 39, lines 1-25. Spain teaches the dry color layer contains binder and pigment (col. 14, lines 57-68). That the PSA layer or overall laminate and its elements are adhered to a surface, or produced at a certain time and temperature and the release liner is peeled away from the dry paint layer are process limitations in a product claim and is given little patentable weight. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

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Spain teaches the clear color coat layer functions as a barrier in a sufficient film thickness (embraces the barrier film thickness requirements as recited, further the barrier is 0.8 mil thick at col. 24, line 42-col. 25, line 6, falling within Applicant's ranges) to prevent color coat pigment particles from migrating from the color coat through the clear coat and penetrating the surface of the clear coat for application to a painted car also containing non-pigmented solids (col. 10, lines 30-40, col. 15, lines 30-col. 16, line 4). The barrier is made of PVDF-acrylic resin composition including a non-pigment and Elvacite (same as Applicant's acrylic resinous composition including a non-pigment as page 25, lines 1-6 describe) at col. 11, lines 45-68 and col. 15, lines 65-col. 16, line 20. Such description is equivalent to Applicant's language to a thin flexible barrier made of material that inhibits migration of discoloration-causing pigments including mono azo discoloration causing pigments from a painted substrate surface that sufficiently and essentially prevents color change in the color layer. Spain teaches color coats can also include metallic flake pigments and teaches the pigments dry on a substrate surface, thereby producing application of a color layer on a substrate surface (col. 37, lines 20-53). Thus, Spain was concerned with preventing defective color pigment transfer to painted surfaces (col. 20, lines 20-42, col. 37, lines 55-col. 38, line 4). That the barrier layer is able to capture or inhibit certain effects as claimed is not germane since it has been held that an element that is "being able to" perform a function is not a positive limitation but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (e.g. when x, then y...). Because the same structural elements are

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provided and produce the same end effects, the instant invention would inherently be expected to perform in the same manner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being obvious over USPN 5,725,712 to Spain et al.

Spain teaches a multilayer decorative dry paint laminate in this order: pressure sensitive adhesive (PSA) (144, Fig. 14 and associated text), thin flexible backing barrier (142, Fig. 14 and associated text), dry paint color layer (46, Fig. 14 and associated text), outer clear color layer (45, Fig. 14 and associated text, releaseable from release liner), release liner (141 or 146, Fig. 14 and associated text, removable). Because the same PSA is taught, it is adapted for adhering the laminate to a substrate surface at room temperature. See further col. 20, lines 20-42, col. 39, lines 1-25. Spain teaches the dry color layer contains binder and pigment (col. 14, lines 57-68). That the PSA layer or overall laminate and its elements are adhered to a surface, or produced at a certain time and temperature and the release liner is peeled away from the dry paint layer are process limitations in a product claim and is given little patentable weight. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce

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it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

Spain teaches the clear color coat layer functions as a barrier in a sufficient film thickness to prevent color coat pigment particles from migrating from the color coat through the clear coat and penetrating the surface of the clear coat for application to a painted car also containing non-pigmented solids (col. 10, lines 30-40, col. 15, lines 30-col. 16, line 4). The barrier is made of PVDF-acrylic resin composition including a non-pigment and Elvacite (same as Applicant's acrylic resinous composition including a non-pigment as page 25, lines 1-6 describe) at col. 11, lines 45-68 and col. 15, lines 65-col. 16, line 20. Such description is equivalent to Applicant's language to a thin flexible barrier having the thickness requirement recited, made of material that inhibits migration of discoloration-causing pigments including mono azo discoloration causing pigments from a painted substrate surface that sufficiently and essentially prevents color change in the color layer. Spain teaches color coats can also include metallic flake pigments and teaches the pigments dry on a substrate surface, thereby producing application of a color layer on a substrate surface (col. 37, lines 20-53). Thus, Spain was concerned with preventing defective color pigment transfer to painted surfaces (col. 20, lines 20-42, col. 37, lines 55-col. 38, line 4). That the barrier layer is able to capture or inhibit certain effects as claimed is not germane since it has been held that an element that is "being able to" perform a function is not a positive limitation but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. Language that suggests or makes optional but does not require steps to be performed or does not

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limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Because the same structural elements are provided and produce the same end effects, the instant invention would inherently be expected to perform in the same manner.

Spain does not expressly disclose the thicknesses of the laminate or barrier as per claim 3.

While Spain teaches the dry film thickness is between 0.5 to 1.5 mils (col. 10, lines 30-40, col. 11, lines 10-20), Spain does not expressly state the thickness is not more than about 10% of the total thickness of the decorative laminate exclusive of the release liner. However, because Spain teaches the film thickness is varied to effect the appearance properties of the paint coat, variation of thickness is an optimizable feature. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. Further optimizing the thickness of the laminate or barrier effects the strength.

Claims 4-5 and 13 are rejected under 35 U.S.C. 103(a) as being obvious over USPN 5,725,712 to Spain et al. and USPN 6,649,003 to Spain et al. (both are applied below as "Spain" alternatively) in view of USPN 5,506,031 to Spain et al. ("Spain '031").

Spain teaches a multilayer decorative dry paint laminate in this order: pressure sensitive adhesive (PSA) (144, Fig. 14 and associated text), thin flexible backing barrier (142, Fig. 14 and associated text), dry paint color layer (46, Fig. 14 and associated text), outer clear color layer (45, Fig. 14 and associated text, releasble contact with release liner), release liner (141, Fig. 14 and associated text, removable). Because the same PSA is taught, it is adapted for adhering the laminate to a substrate surface at room temperature. See further col. 20, lines 20-42, col. 39, lines 1-25. Spain teaches the dry color layer contains binder and pigment (col. 14, lines 57-68).

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That the PSA layer or overall laminate and its elements are adhered to a surface, or produced at a certain time and temperature and the release liner is peeled away from the dry paint layer are process limitations in a product claim and is given little patentable weight. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

Spain teaches the clear color coat layer functions as a barrier in a sufficient film thickness to prevent color coat pigment particles from migrating from the color coat through the clear coat and penetrating the surface of the clear coat (equivalent to Applicant's thickness requirements) for application to a painted car also containing non-pigmented solids (col. 10, lines 30-40, col. 15, lines 30-col. 16, line 4). The barrier is made of PVDF-acrylic resin composition including a non-pigment and Elvacite (same as Applicant's acrylic resinous composition including a non-pigment as page 25, lines 1-6 describe) at col. 11, lines 45-68 and col. 15, lines 65-col. 16, line 20. Such description is equivalent to Applicant's language to a thin flexible barrier made of material that inhibits migration of discoloration-causing pigments including mono azo discoloration causing pigments from a painted substrate surface that sufficiently and essentially prevents color change in the color layer. Spain teaches color coats can also include metallic flake pigments and teaches the pigments dry on a substrate surface, thereby producing application of a color layer on a substrate surface (col. 37, lines 20-53). Thus, Spain was

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concerned with preventing defective color pigment transfer to painted surfaces (col. 20, lines 20-42, col. 37, lines 55-col. 38, line 4). That the barrier layer is able to capture or inhibit certain effects as claimed is not germane since it has been held that an element that is "being able to" perform a function is not a positive limitation but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. Nevertheless, because the same structural elements are provided and produce the same end effects, the instant invention would inherently be expected to perform in the same manner (regarding instant claims 4-5).

Spain does not expressly teach a fine particulate additive of a metal oxide dispersed in the acrylic resinous material in an amount to cause reduction of migration of pigments.

Spain '031 teaches a coat of acrylic resinous PVDF including a fine particulate additive such as aluminum silicate dispersed therein in order to produce color in dry paint finish laminates (col. 8, lines 1-10, and Examples 1 and 5).

It would have been obvious to one having ordinary skill in the art to have modified the multilayer film of Spain to have included a fine particulate additive of a metal oxide dispersed in the acrylic resinous material because Spain '031 teaches a coat of acrylic resinous PVDF including a fine particulate additive such as aluminum silicate dispersed therein in order to produce color in decorative dried paint print laminates (col. 7, line 65-col. 8, line 10, and Examples 1 and 5 of Spain '031). Further it is obvious to include the metal compounds in an amount to bring about the desired effect because the same materials are used and in combination would produce the claimed invention and functionality. Also the amount of metal used directly

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effects the opacity and color. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272.

Claim 6 is rejected under 35 U.S.C. 103(a) as being obvious over USPN 5,725,712 to Spain et al. and USPN 6,649,003 to Spain et al. (both are applied below as “Spain” alternatively) in view of USPN 5,506,031 to Spain et al. (“Spain ‘031”) and further in view of USPN 5,084,317 to Epple.

Spain teaches a multilayer decorative dry paint laminate in this order: pressure sensitive adhesive (PSA) (144, Fig. 14 and associated text), thin flexible backing barrier (142, Fig. 14 and associated text), dry paint color layer (46, Fig. 14 and associated text), clear color layer (45, Fig. 14 and associated text), release liner (141 or 146, Fig. 14 and associated text, removable). Because the same PSA is taught, wound in rolls, and the production of a plastic siding panel substrates with a surface resembling natural wood grain is taught as the application for the multilayer paint laminate, it would have been obvious to one having ordinary skill in the art for the laminate to adhere to a substrate surface at room temperature (col. 1, lines 10-40, col. 3, lines 15-51, col. 6, lines 15-50). See further col. 20, lines 20-42, col. 39, lines 1-25. Spain teaches the dry color layer contains binder and pigment (col. 14, lines 57-68). That the PSA layer or overall laminate are produced at a certain time and temperature and the release liner is thereafter peeled away from the dry paint layer are process limitations in a product claim and is given little patentable weight. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F.

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2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

Spain teaches the clear color coat layer functions as a barrier in a sufficient film thickness to prevent color coat pigment particles from migrating from the color coat through the clear coat and penetrating the surface of the clear coat for application to a painted car also containing non-pigmented solids (col. 10, lines 30-40, col. 15, lines 30-col. 16, line 4). The barrier is made of PVDF-acrylic resin composition including a non-pigment and Elvacite® (same as Applicant's acrylic resinous composition including a non-pigment as page 25, lines 1-6 describe) at col. 11, lines 45-68 and col. 15, lines 65-col. 16, line 20. Such description is equivalent to Applicant's language to a thin flexible barrier made of material that inhibits migration of discoloration-causing pigments including mono azo discoloration causing pigments from a painted substrate surface that sufficiently and essentially prevents color change in the color layer. Spain teaches color coats can also include metallic flake pigments and teaches the pigments dry on a substrate surface, thereby producing application of a color layer on a substrate surface (col. 37, lines 20-53). Thus, Spain was concerned with preventing defective color pigment transfer to painted surfaces (col. 20, lines 20-42, col. 37, lines 55-col. 38, line 4). That the barrier layer is able to capture or inhibit certain effects as claimed is not germane since it has been held that an element that is "being able to" perform a function is not a positive limitation but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. Nevertheless, because the same structural

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elements are provided and produce the same end effects, the instant invention would inherently be expected to perform in the same manner (regarding instant claims 4-5).

While Spain teaches the dry paint layer comprising clear coat 45 is a transparent film on a carrier surface (col. 9, lines 19-22), Spain does not teach a matte release coat on the carrier.

Spain '031 teaches the lower surface of a carrier (26, Fig. 2 and 6 and associated text) is in contact with a matte release layer (24, Fig. 2 and 6 and associated text) to form a matte surface on the carrier sheet resulting in low surface gloss (col. 9, lines 55-68) and to freely release a carrier during a transfer process (col. 10, lines 1-5).

It would have been obvious to have modified the multilayer film of Spain to have included a matte release coat as claimed because Spain '031 teaches the lower surface of a carrier (26, Fig. 2 and 6 and associated text) is in contact with a matte release layer (24, Fig. 2 and 6 and associated text) to form a matte surface on the carrier sheet resulting in low surface gloss (col. 9, lines 55-68) and to freely release a carrier during a transfer process (col. 10, lines 1-5).

Spain does not teach winding or unrolling of a laminate as a self-wound laminate to perform as a rolled tape construction when releasing a surface as claimed.

Epple teaches an adhesive release of cured silicone adjacent adhesive (20 and 22, Fig. 2 and associated text) and adjacent to release liners (12 and 14, Fig. 2) self wound in a roll to release to adhere to automotive parts (col. 5, lines 1-66, Fig. 2 and 2a and Fig. 4-5).

It would have been obvious to one having ordinary skill in the art to have modified the combination to include winding or unrolling of a laminate as a self-wound laminate to perform as a rolled tape construction when releasing a surface as claimed because Epple teaches an

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adhesive release of cured silicone adjacent adhesive (20 and 22, Fig. 2 and associated text) and adjacent to release liners (12 and 14, Fig. 2) self wound in a roll to release to adhere to automotive parts (col. 5, lines 1-66, Fig. 2 and 2a and Fig. 4-5). The combination produces the instant claimed invention because the same construction and order is provided and would perform as claimed.

Allowable Subject Matter

Claims 11, 14, and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and submitting the proper documentation to overcome the common ownership (see below). The applied prior art does not teach a multilayer decorative laminate including a matte release coat as recited and provides no suggestion to modify the dry paint layer as the claim recites.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Regarding to the arguments of anticipation, Spain '712 does not teach the thickness requirements, Spain explicitly teaches the clear coat is at sufficient film thickness that acts as a barrier to prevent the color coat pigment particles from migrating from the color coat through the clear coat and penetrating the surface of the clear coat (col. 15, lines 20-35) and made of the same PVDF material (col. 15, lines 40-50), the thickness requirements of 1.6 mils or less, or from about 0.05 to about 0.20 mils is met. Applicant argues Spain '712 teaches a backing is disclosed as flexible but supportive and would not function as a barrier, however, the exact same

material is used and would indeed provide the same function. It is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art.” *In re Swinehart et al.*, 169 USPQ 226 at 229. Since the Spain references teaches all of Applicant’s claimed compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

Further regarding Spain ‘003, the anticipation is maintained because Spain explicitly teaches the clear color coat layer functions as a barrier in a sufficient film thickness (embraces the barrier film thickness requirements as recited) to prevent color coat pigment particles from migrating from the color coat through the clear coat and penetrating the surface of the clear coat for application to a painted car also containing non-pigmented solids (col. 10, lines 30-40, col. 15, lines 30-col. 16, line 4). The barrier is made of the same PVDF-acrylic resin composition including a non-pigment and Elvacite (same as Applicant’s acrylic resinous composition including a non-pigment as page 25, lines 1-6 describe) at col. 11, lines 45-68 and col. 15, lines 65-col. 16, line 20.

Applicant argues the color-prevention properties of the barrier layer is clearly defined in the specification, however, the specification is not read into the claims.

Applicant argues the product-by-process language, despite the language, because the same structural elements are provided and produce the same end effects, the instant invention would inherently be expected to perform in the same manner (regarding instant claims 4-5).

Applicant argues that while the material of the barrier/clear coat layer(s) is the same as the instant invention, that amending the claims to a “dry film thickness” distinguishes clearly over the barrier layer function. This argument is not persuasive, because the same material is provided and making it thicker or thinner is optimizable as thickness certainly effects the strength, absent Applicant’s submission of objective evidence.

Applicant further points to the barrier properties of Spain ‘712, however because the exact same material is used, that Applicant has found other properties (temperature, discoloration prevention, or migration effects) that are inherently present is not convincing, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Moreover, Spain (003 and 712) teach the barrier material is of Elvacite and PVDF-acrylic (same material as Applicant) and Spain ‘003 teaches the barrier is in a sufficient film thickness to prevent color coat pigment from migrating from the color coat, this has the exact same meaning, and solves the exact same problem of Applicant’s discoloration prevention property.

Applicant argues Spain ‘031 doesn’t teach the barrier, however, Spain ‘031 was not used to show a discoloration barrier because the other Spain references teach the same barrier material. See the rationale above.

Eppel is still used to teach winding or unrolling of a laminate as a self-wound laminate to perform as a rolled tape construction when releasing a surface as claimed as Eppel teaches an adhesive release of cured silicone adjacent adhesive (20 and 22, Fig. 2 and associated text) and

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adjacent to release liners (12 and 14, Fig. 2) self wound in a roll to release to adhere to automotive parts (col. 5, lines 1-66, Fig. 2 and 2a and Fig. 4-5).

A *prima facie* case has been established, and therefore the burden shifts to the Applicant to submit additional objective evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art. Arguments of counsel cannot take the place of factually supported objective evidence. See, e.g., *In re Huang*, 100 F.3d 135,139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); *In re De Blauwe*, 736 F.2d 699,705, 222 USPQ 191, 196 (Fed. Cir. 1984). Until the Applicant has convincingly argued or has provided evidence to the contrary, the rejections are maintained. Once a reference teaching product appearing to be substantially identical is made the basis of a rejection, and the Examiner presents evidence or reasoning tending to show inherency, the burden shifts to the Applicant to show an unobvious difference. “[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency’ under 35 U.S.C. 102, on *prima facie* obviousness’ under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted].” See MPEP 2112.

In order for Applicant to overcome the 102/103 rejections having the same assignee,

Applicant desires the 102(e) rejection over Spain ‘003 to be removed, but has not submitted a sworn statement under oath as required by 37 CFR 1.132. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending

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application. This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991). See also MPEP 706.02(b) [R-3].

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

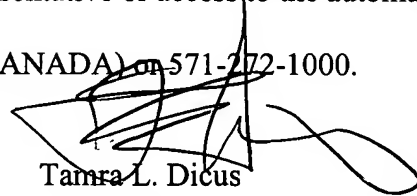
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

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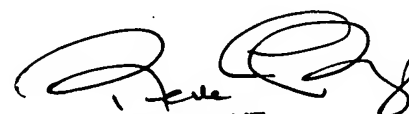
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tamra L. Dicus
Examiner
Art Unit 1774

June 12, 2006



RENA DYE
SUPERVISORY PATENT EXAMINER
A.U. 1774 6/23/06